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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/962,040	10/31/97	CARNEY J	MK

HM12/0428

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EXAMINER	
JONES, D	

ART UNIT	PAPER NUMBER
1614	10

DATE MAILED: 04/28/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/962,040	Applicant(s) Carney et al.
	Examiner Dwayne C. Jones	Group Art Unit 1614

☒ Responsive to communication(s) filed on *the election of December 31, 1998* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *17-51* is/are pending in the application.

Of the above, claim(s) *17-27* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *28-51* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *17-27* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *3,6 and 8*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Status of Claims

1. Claims 17-51 are pending.

2. Claims 28-51 are elected and rejected.

3. Claims 17-27 are non-elected and withdrawn from consideration.

Election/Restriction

4. Applicants' election without traverse of group II, corresponding to claims 28-51 in Paper No. 9 is acknowledged.

Information Disclosure Statement

5. The Information Disclosure Statements filed February 27, 1998, September 14, 1998 and January 4, 1999 have been received and considered, see enclosed copies of PTO FORMs 1449.

Claim Rejections - 35 USC § 112

6. Claims 28, 36, 37, 39, 40, 43, 45, 50 and 51 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the spin trapping compounds disclosed commencing on page 8, line 3 through page 18, the third compound, does not reasonably provide enablement for *other* types of derivatives of spin trapping compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is

most nearly connected, to make or use the invention commensurate in scope with these claims. The specification does not provide support or guidance to make or use *other* types of derivatives or spin trapping compounds other than recited in the instant specification from page 8, line 3 through page 18, the third compound. Furthermore, the specification fails to provide support or guidance to treat a patient suffering from a dysfunction or a disease condition arising from oxidative damage with other derivatives. Without such information, one skilled in the art could not predict which analogs or prodrugs out of the vast numbers of potential derivatives would react to treat a patient suffering from a dysfunction or a disease condition arising from oxidative damage. Accordingly, one skilled in the art would be required to perform undue experimentation to identify any *other* derivatives which could be used in conjunction with the spin trapping compounds disclosed commencing on page 8, line 3 through page 18, the third compound. Therefore, one skilled in the art could not make or use the invention without undue experimentation.

7. Claims 28 and 30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating a patient suffering from a dysfunction or a disease condition arising from oxidative damage due to ultraviolet radiation, does not reasonably provide enablement for treating a patient suffering from a dysfunction or a disease condition arising from oxidative damage. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The phrase of, " treating a patient suffering from a dysfunction or a

disease condition arising from oxidative damage" fails to enable the skilled artisan with guidance or direction to select which types of diseases can arise from oxidative damage. This terminology of from a dysfunction or a disease condition arising from oxidative damage also has a large scope. In the absence of such information, the artisan could not predict which diseases other than those specifically directed to oxidative damage due to ultraviolet radiation out of the plethora of disease states due to oxidative damage. And so, the skilled artisan would be required to perform undue experimentation to identify other disease states directed to oxidative damage.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 28-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. of GB 1,109,473. Cox et al. teach of a generic disclosure of the compounds of the general formulae R-CH=N(->O)R^1 and R-N(->O)CH=CH-N(->O) R^1 wherein R or R^1 is aryl or substituted aryl or heterocyclic radical, (see page 1, lines 20-30). The claims differ from the reference by reciting a specific species and a more limited genus than the reference. The skilled artisan would, however, been motivated to select any of the species of the genus taught by the reference because an

ordinary artisan would have the reasonable expectation that any of the species would have similar properties and, thus, the same use as the genus as a whole.

10. Claims 28-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlesinger of U.S. Patent No. 3,775,122. Schlesinger teaches of compounds of the following formulae $R_1R_2C=N(->O)R_3$, wherein R_1 and R_3 can be any alkyl or aryl group or substituted alkyl or aryl group, R_2 may be hydrogen, alkyl, substituted alkyl or aryl, (see page 1, lines 20-30). The claims differ from the reference by reciting a specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those of the claims, since an ordinary artisan would have the reasonable expectation that any of the species would have similar properties in addition to possessing the same use as the genus as a whole.

11. Claims 28-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorschner et al. of U.S. Patent No. 3,834,073 possessing a publication date of September 10, 1974. Dorschner et al. specifically teach of the compounds of formula I, (as recited in column 1, lines 53-60 and from column 3, line 30 to column 4, line 2). The claims differ from the reference by reciting a specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those of the claims, since an ordinary artisan would have the reasonable expectation that any of the species would have similar properties in addition to possessing the same use as the genus as a whole.

Obviousness-type Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 28-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-18 of U.S. Patent No. 5,025,032. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 5,025,032 discloses of a phenyl butyl nitrone compound, which is what the instant invention is also claiming.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

D. C. Jones
Primary Examiner, Tech. Ctr. 1614
April 24, 1999